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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK EXAMINING OPERATION

Applicant: KEIL, KURT

Serial No.: 09/892,359

Filed: June 28, 2001

Mark: STRUCTURAL TUBING MEMBERS  
WITH FLARED OUT END SEGMENTS  
FOR CONJOINING

Group Art Unit: 3637

Docket No.: KK#2-3

Preliminary Class: Unknown

Examiner: Phi Dieu Tran A

Via Central Fax: 571/273/8300

**FIRST REPLY BRIEF ON MERITS TO THE  
NON-FINAL PTO ACTION OF NOVEMBER 18, 2005**

Commissioner for Patents  
Box 1450  
Alexandria, VA 22313-1450

Sirs:

The PTO Official Letter of 07/27/2005 was a final action, except to allow original claims 1 to 20 and 23 as amended. That action was affirmed by the Applicant's paper filed on October 31, 2005, canceling the finally-rejected claims 21, 22, 24, 25, and 26, and providing two copy sets (marked up set and a clean claim set) of the allowed claim set and seeking a formal Notice of Allowance.

Despite that timely reply, the Primary Examiner has reopened the prosecution of the present case to make newly of record 3 U.S. patents, all of which predated the effective filing date (March 1999) of the present case, but had not been made of record heretofore in either case. The Applicant has studied the new citations and will now set forth their lack of anticipatory value and the lack of need for any substantive changes in the pending claim set here, but will set forth a legal basis for restoring, long-pending claims 1, 6, 10, 18, and 19 to their former status of

being allowable subject matter, as presented.

Rider SUM is a recap sheet of all claims present or canceled. Rider MKD is the marked up version of now amended claim 11, and Rider CLN is the clean version of the amended claim 11. All other claims stand unamended at this writing.

#### REMARKS

Claim 11 is newly rejected under § 112(2) as being indefinite. Independent claim 11 has been rewritten in part as set forth in subparagraph (a) as follows:

“... a first member is maintained intact, while at least one of the complementary end sidewalls of a second member includes a first pair of externally-placed linear groovings, etc.”

The just-described feature is typically depicted in specification Figures 6P, 6S, and 6E. The marked up claim 11 which is enclosed, will reflect these changes as well, as do the clean set of originally allowed claims 1 to 27. In Fig. 6P, note that the hidden sidewall member partly conceals extended finger 88. It is maintained intact while the endwall 92B of vertical member 86 has a first pair of groovings, 96L/R. The clearly hidden sidewall has like set of groovings to provide for the depicted flaring segment 88. Dependent claim 11 should now be allowable and such action is respectfully sought.

#### TRAVERSAL OF THE OBVIOUSNESS REJECTION PER § 103.

As to claims 1, 4, 6, 10, and 18, the Examiner now rejects them over Ecket 1,817,449, in view of Daniels '993. This ground of rejection is respectfully traversed based on the following remarks, and by relying on the continuing patentable distinctiveness of the claims at issue.

Note that the citation Ecket embodiments of Figs. 7, 8, and 9, are all side elevational views of their once-patented bracing studs; as a fire block, as a bridging member, and an enclosed brace, respectively. Note also that none of those are structural tubing members with

intact, integral flared out ends. The basic U-shaped “blank sheet of metal” member of Ecket is not, nor can be, reformed into the tubular members of the present invention, most of which have at least four closed sidewalls. Ecket teaches only an inverted channel member for scoring and dissimilar indentations.

The broadest independent claim 1 of this invention recites “a first pair of externally-placed, linear groovings of being located arrayed in parallel, with each of the groovings being located proximal to each of the two seams of a single member sidewall in one planar surface of the member, etc.”

Ecket neither discloses, nor suggests, modification of its bracing studs to meet such recited features. The most significant parallel elements of Ecket are the upraised linear fluting 19 (see Figs. 4 & 5), which optimal fluting is integrally formed with central planar surface 11 of the brace. The large plurality of transverse scores 21, while adapted to permit end plate longitudinal projection by bending upwardly, are plainly not a pair of longitudinal, elongated and parallel pair of groovings proximal to seams of the single member sidewall as depicted in presents Figs. 14 through 17 (all of which have tubing cross sections). The spaced-apart parallel scorings 20 of Ecket’s Fig. 31 become the opposing elongate channel configuration of that article, when it is converted to the sidewall depending configuration of his Figs. 5 & 6.

The single pair of two linear indentations 20 of Fig. 1, clearly do not permit separation “under force at least an initial finger from one sidewall.” The resulting end plate 15 of his Fig. 6, requires that the companion end-rounded plurality of transverse scores 21 to be employed with one linear pair 20 indentations, so as to effect the erect end plate 15 of Fig. 6. To obtain the resulting flared tubing ends, the , linear groovings (like 96L/R of Fig. 6P) of our recited members are required.

This complex Ecket starting member Fig. 1 and 2, 5, and 6, neither anticipates nor suggests the presently claimed rigid tubing member with its carefully sized and located paired linear groovings. The tubular members are only adapted to produce one or more end fingers tabs, by using a disclosed flaring tool (see Fig. 21S). All of this is accomplished while maintaining the structural integrity of the separated sidewall finger. Such a functional feature is not seen in Ecket. Both elongate indentations and plural transverse scorings 21 are required to produce his modified embodiment of Fig. 6.

Ecket's structure brace/block 10 cannot work to serve remotely once modified to a tubular member to achieve his three stated applications (Figs. 7-9), for his starting member. His blank sheet inherently requires being an inverted U-shaped elongate channel, so to permit the choice of a variable longitudinal position for segment (plate) 15 of Fig. 6. There is simply no motivation to convert the inverted U-shaped channel to tubular form. Rejection of claim 1 is no longer tenable, in light of the inherent structural annotations recited and the converse purpose of Ecket member. This precludes any reading of the present claims on the Ecket bridging member, or the suggested reconstruction of the Examiner.

The Examiner concedes that Ecket does not show the second (or first) member as being a tubular member. He would seek to cure this prior art (Ecket) description insufficiency by invoking the 1977 teaching of Daniels '993, said to teach a tubular member. This citation is directed to a sheet metal, pole stud 12, as seen in Fig. 1 thereof. Daniels requires a top and bottom plate, with such plates also requiring a strip of particle board, 40/42. Except by the invoking of proscribed hindsight, there is no apparent thought here to find a motivation to define the U-shaped member of Ecket to be replaced by the closed tubular member of Daniels. The secondary citation's structure depicts no parallel array of linear groovings that would recommend it as an alternative

device for having a cross section for that of Ecket. Where would the plural scores of Ecket go in the member 17 of Daniels, and for what possible purpose? The resort to Daniels to cure the

Described limits of Ecket is a contrived one, predicated on hindsight reconstruction of Ecket, in an impractical manner devoid of suggestion or motivation being seen in either citation.

Dependent claim 19, incorporates all the recited features of parent main claim 1, from which it depends was rejected over the hindsight melding of Ecket, Daniels, and now Kolvites '337. The ground of rejection is respectfully traversed on two major bases, the first being the foregoing narrative above that independent claim 1, as amended is neither anticipated (it cannot be based upon Ecket), secondary, nor does the prior citation suggest its modification to engraft the materials of construction of the Kolvites patent. This 1993 cited patent does have tubular support beams, like 12, of Fig. 1, but they are not designed to be cut to any desired length, on a job site, nor to then have their longitudinal ends adapted to be flared and so to create a myriad of attachment shapes, as will be depicted in the present disclaimer. The marginal elements of Kolvites go to a teaching of using a pultruded thermosetting plastic resin as the material of construction of his member.

It is axiomatic action that a dependent claim to a preferred embodiment of the invention incorporates all the limitations of the parent claim. In other words, the embodiment of claim 9 does not rely solely on its stated features for its patentability but carries with it the distinctiveness of the parent claim from which it depends.

On the overall proposition of raising improper hindsight to define a problem of the art in terms of the solution, Fed. Ct. has spoken. It observed that:

“defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness. 56 USPQ 2d at 1073, 227 S. Sec. 3<sup>rd</sup>, 1361 (Fed. Cir. 2000).”

Kolvite's use of a certain plastic thermosetting in the tubes that have no linear grooving, does not suggest the present use selected thermoplastic resin in our tubular structures.

With the foregoing analysis showing the structure conflict of Ecket brace with the stud of Daniels, one must now address the rules of practice relating to an Examiner's need for a finding of motivation to combine facially disparate teachings. The asserted combination of such teachings here, fails on two counts: (1) no motivation to combine or modify when references teaches away; or (2) no motivation when the proposed modification would render the Ecket device inoperable. Compare McGinley, '262 F. 3d at 354, USPQ 2d at 1016, (Fed. Cir. 2001).

As earlier touched upon, modifying Ecket's U-shaped channel member with the varied plurality of scorings, by omitting same as shown in Daniels, would render an Ecket stud, such that it could not have a variable position plate which is essential to the stated uses of the Ecket stud. It follows the asserted citation combination here is plainly inoperable and cannot cure the defects of the primary site.

In light of the foregoing discussion of claims features and pertinent patent law and attempting to combine references, a favorable reconsideration of pending claims 1, 4, 6, 10, 18 and 19 and also of objected to claim 2, 3, 5, and 7 (depending from dependent claim 1) be reconsidered. In summing up original claims 8, 9, 15, 16, and 17, 20, and 23 stand allowed in the Office Action of 11/08/2005. Dependent claims 10, 12-14 (based on original claim 11) were said to be allowable if rewritten to overcome the objection of claim 11. As claim 11 has now been rewritten to meet the Examiner's objection, then dependent claims 11, 12, 13, and 14 should now also be deemed allowable, as well.

The rejection of claims 1, 4, 6, 10, and 18 each directed to a single tubular member have

been traversed over the newly cited patents, and are deemed to be in condition for formal reallowance over such differing art. Similarly, the objected to claims 2, 3, 5, 6 and 7, objected to as dependent upon traversed rejected base claim 1 and/or claim 11 should be favorably reconsidered. Reconsideration and allowance of claims 1 to 20, and 23 is respectfully solicited.

Jan 21, 2006

Enclosures:

Rider SUM  
Rider MKD  
Rider CLN  
Drawing from E sheet '449

Respectively,

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**CERTIFICATE OF MAILING**

I hereby certify that this paper is being deposited with the United States Postal Service on January \_\_, 2006 as in an envelope addressed to: Commissioner of Trademarks, Box 1451, Alexandria, VA. 22313-1451

Date: January 21, 2006

Arthur R. Eglington

Arthur R. Eglington, Esq.

RIDER SUM – CURRENT STATUS OF ALL PENDING CLAIMS USN 09/892,359

Replying to PTO Action of 11/08/05

1. Rejected as of 11/2005
2. Allowed as of 4/2005
3. “
4. Rejected as of 11/2005.
5. Allowed as of 4/2005
6. Rejected as of 11/2005.
7. Objected to as of 4/2005.
8. Allowed as of 11/2005
9. Allowed as of 11/2005
10. Rejected as of 11/2005.
11. Amended in reply to PTO Action of 11/08/2005 to make allowable.
12. “
13. “
14. “
15. Allowed as of 4/2005.
16. “
17. “
18. Rejected as of 11/2005.
19. “
20. Allowed as of 11/05.
21. Cancelled 8/2005.

22. “

23. Allowed as of 11/05.

24. Cancelled as of 8/2005.

25. “

26. “

RIDER MKD- REPLY BRIEF OF JANUARY 2006 IN USSN 09/892,359

11. (Twice amended) A pair of conjoined tubular members of variable length and like rectangular cross-sections, formed from sheet steel stock, each having a narrower internal dimensional span and a comparatively wider external dimensional span wherein:

(a) the internal span of one opposing pair of complemental end sidewalls of a first member [which is left] is maintained intact, while at least one of the complemental end sidewalls of a second member [and as to the one end sidewall it] includes a first pair of externally-placed, linear groovings arrayed in parallel, with each of the groovings being located proximal to one of the elongate opposing seams in one planar surface of the member, and each of the groovings being of a depth sufficient to facilitate separation under force of at least an initial finger from one sidewall end segment from the adjacent two sidewall end segments, while maintaining the structural integrity of the transverse dimension of the separated sidewall end segment at the end point of separation which has been flared outwardly and fixedly and so that:

(b) the internal dimensional span of the first pair of sidewalls of the second member snugly straddles the narrower external dimensional span of the other intact first member for purposes of member conjoining at a point along the longitudinal dimensions of the first tubular member.

RIDER CLN-REPLY BRIEF OF JANUARY 2006 IN USSN 09/892,359

11. (Twice amended) A pair of conjoined tubular members of variable length and like rectangular cross-sections, formed from sheet steel stock, each having a narrower internal dimensional span and a comparatively wider external dimensional span wherein:

(a) the internal span of one opposing pair of complementary end sidewalls of a first member is maintained intact, while at least one of the complementary end sidewalls of a second member includes a first pair of externally-placed, linear groovings arrayed in parallel, with each of the groovings being located proximal to one of the elongate opposing seams in one planar surface of the member, and each of the groovings being of a depth sufficient to facilitate separation under force of at least an initial finger from one sidewall end segment from the adjacent two sidewall end segments, while maintaining the structural integrity of the transverse dimension of the separated sidewall end segment at the end point of separation which has been flared outwardly and fixedly and so that:

(b) the internal dimensional span of the first pair of sidewalls of the second member snugly straddles the narrower external dimensional span of the other intact first member for purposes of member conjoining at a point along the longitudinal dimensions of the first tubular member.